



IN THE US PATENT AND TRADEMARK OFFICE

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In re Application of: Newman, S.
Application No: 10/039927
Filed: October 26, 2001
For: *Electrostatic Discharge Testing Apparatus*

Group Art Unit: FEB 28 2002
Batch: TC 2800 MAIL ROOM
Examiner: Date: January 25, 2002

INFORMATION DISCLOSURE STATEMENT

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

This Information Disclosure Statement is submitted:

- under 37 CFR 1.97(b), or
- under 37 CFR 1.97 (c) together with either a :
 statement under 37 CFR 1.97(e), or
 a \$240 fee under 37 CFR 1.17(p), or
- under 37 CFR 1.97(d) together with a:
 statement under 37 CFR 1.97(e), and
 a petition under 37 CFR 1.97 (d)(2): Applicant requests consideration of this information disclosure statement, and
 a \$130 petition fee set forth in 37 CFR 1.17(i)

Applicant submit herewith Form PTO 1449 information that may be material to the examination of this application and for which there may be a duty to disclose in accordance with 37 CFR 1.56.

copies of the patents, publications, or other information listed on the Form PTO 1449 are enclosed.

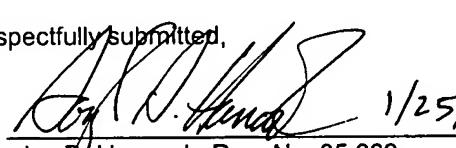
the information listed in the attached Form PTO 1449 was previously cited by or submitted to the Office in a prior application, No. , upon which the present application relies for an earlier filing date under 35 USC § 120. Consequently, copies of this information are not provided here (37 CFR 1.98(d)).

As respects information listed in the PTO Form 1449 that is not in the English language:

A concise explanation of the relevance, as presently understood, of such information is attached hereto;

the foreign language document was cited in a search report or other action by a foreign patent office in a counterpart application, thus an English language version of the search report or action which indicates the degree of relevance found by that office is listed on Form PTO 1449 and enclosed herewith.

Respectfully submitted,

By:  1/25/02
Douglas D. Hancock, Reg. No. 35,889

ipsolon llp
Customer No. 21034



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PATENT
Atty Docket No. 1278-001/ddh

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FEB 28 2002

TC 2800 MAIL ROOM

First Named Inventor: Newman, S.
Application Number: 10/039927
Filing Date: October 26, 2001
Title: Electrostatic Discharge Testing Apparatus

Examiner:
Art Unit:

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR 1.56**

Assistant Commissioner for Patents
Washington, D.C. 20231

I, Scott Newman, inventor named in the above patent application, make the following statement pursuant to my duty of disclosure under 37 CFR § 1.56. This statement is based upon my personal knowledge and best recollection.

1. I have experience in the field of testing work surfaces for electrostatic discharge (ESD) potential. I began working on a prototype "mobile" ESD testing apparatus in about mid-1998. By about early 1999 I had developed a first prototype unit, referred to herein as the "first prototype."

2. The first prototype included the following features:

- Wheeled frame;
- Electrically conductive wheels that could be connected to an ohmmeter
- Industry standard electrodes that could be connected to the ohmmeter

The wheels used in the first prototype were quite hard and did not contact the floor very well—the conductivity of the wheels was not very good—it was in the range of 0.25 to 5.0 mega-ohms. The electrodes were simply carried on the wheeled frame from location to location—they were not mounted on the frame but were instead carried on a platform on the frame (the "fram" " was a hand truck

and the electrodes were simply placed on the hand truck platform). The first prototype was unable to perform point to point floor testing according to industry standards, was unable to perform point to ground testing according to industry standards, and was unable to perform bench to floor testing according to industry standards. However, the frame provided a method to move the relatively heavy electrodes from location to location. When I wanted to run a test, I wheeled the unit to the desired location and then removed the electrodes and physically placed them on the work surface to be tested, separating them by the appropriate spacing. The electrical resistance between the wheels could be measured while the frame was being moved, but the spacing between the wheels could not be adjusted.

3. In about the spring of 1999 while visiting with two other engineers who are familiar with ESD testing, I mentioned that I was working on a prototype mobile ESD testing apparatus. They expressed interest in what I was doing, and I was interested in hearing their feedback on the unit. However, prior to revealing anything about my first prototype to these individuals, I told them that the unit was confidential, that my work was a secret, and that I would agree to show the unit to them only on the condition that they agree to keep the information confidential. Both agreed to these conditions. The confidentiality agreement was oral—there was no written agreement between the engineers and myself.

4. A week or two after I showed the first prototype to the two engineers, one of them called me and asked me if I would permit him to build a similar unit. I told him that I would permit him to do so, but only if he agreed to (a) maintain the confidentiality of the unit and use it only himself and not reveal it to others; and (b) share with me the results of his building and testing efforts. I hoped that the results of his testing would assist in my continuing development of the unit. He agreed to these conditions. Again, the agreement was oral—there was no written agreement.

5. In 2000 the engineer whom I had permitted to build a unit visited me and we discussed the ESD testing units. He provided me with information

about the unit he had built, and the tests he had performed. At that time I reminded the engineer about our agreement to keep the unit confidential. When I asked him whether he had disclosed the unit to anyone, he assured me that except for a few people who I believe work nearby him, he had kept the unit secret as agreed.

6. On July 24, 2001 I again spoke with the engineer whom I had permitted to build a unit. At that time he told me that he had shown the prototype that he had made to an individual who sells ESD flooring products. I do not know when the engineer showed the prototype to this individual. The engineer also told me on this occasion that he had "probably" showed the unit to a couple of others, but he could not remember anyone in particular.

7. My first prototype unit is different from the unit disclosed in my patent application in many respects. To name a few, in the first prototype (a) the electrodes were not mounted to the frame; (b) there was no mechanism for moving the electrodes from a retracted position to an extended position, (c) there was no switching circuitry for selectively testing either the resistance between the wheels or the electrodes; (d) the wheels were fixed and the spacing between them could not be adjusted; (e) there was no mechanism for facilitating an electrode up position or an electrode down position; (f) the coating material used on the wheels was hard and had low conductivity values; and (g) there was no switching circuitry that allowed an "automatic mode" as disclosed in my application.

Respectfully Submitted,

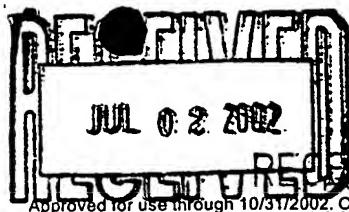


Scott Newman 1-25-02



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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

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First Named Inventor	Newman, S.
Group Art Unit	
Examiner Name	
Total Number of Pages in This Submission	5
Attorney Docket Number	1278-001/ddh

ENCLOSURES (check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Douglas D. Hancock, Reg. No. 35,889
Signature	
Date	Jan 25, 2002

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: Jan 25, 2002

Typed or printed name	Douglas D. Hancock
Signature	
Date	Jan 25, 2002